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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,079	07/16/2003	Kenneth L. Levy	P0856	1849
23735	7590	05/25/2010		
DIGIMARC CORPORATION			EXAMINER	
9405 SW GEMINI DRIVE			WILLIAMS, JEFFERY L.	
BEAVERTON, OR 97008				
			ART UNIT	PAPER NUMBER
			2437	
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			05/25/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/622,079

**Applicant(s)**

LEVY ET AL.

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40,41 and 52-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40,41 and 52-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This action is in response to the communication filed on 2/18/10.

All objections and rejections not set forth below have been withdrawn.

Claims 40, 41, 52-63 are pending.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the added features of *"identifying a subset of the list of content items highlighted as active content items, the subset comprising content items subject to updates"; "deriving at least one fingerprint from a content item monitored or obtained"; "to identify the monitored or obtained content item"* (Claim 40); *"said act of deriving comprises deriving two or more fingerprints of the content item"* (Claim 52), and *"said act of interrogating the list of content items utilizes the two or more fingerprints"* (Claim 53) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

1 is to be canceled, the appropriate figure must be removed from the replacement sheet,  
2 and where necessary, the remaining figures must be renumbered and appropriate  
3 changes made to the brief description of the several views of the drawings for  
4 consistency. Additional replacement sheets may be necessary to show the renumbering  
5 of the remaining figures. Each drawing sheet submitted after the filing date of an  
6 application must be labeled in the top margin as either "Replacement Sheet" or "New  
7 Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,  
8 the applicant will be notified and informed of any required corrective action in the next  
9 Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

14 The abstract of the disclosure is objected to because the amendment of 5/1/08  
15 introduces new matter. See Objection to the Specification below. Correction is  
16 required. See MPEP § 608.01(b).

18 The specification is objected to as failing to provide proper antecedent basis for  
19 the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction  
20 of the following is required:

21 The specification fails to provide proper antecedent basis for the recitations of  
22 *"identifying a subset of the list of content items highlighted as active content items, the*

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subset comprising content items subject to updates"; "deriving at least one fingerprint from a content item monitored or obtained"; "to identify the monitored or obtained content item" (Claim 40); "said act of deriving comprises deriving two or more fingerprints of the content item" (Claim 52), and "said act of interrogating the list of content items utilizes the two or more fingerprints" (Claim 53).

**Claim Rejections - 35 USC § 112**

**The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 40, 41, 52-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitations in the application as filed (see above objection to the specification).

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 40, 41, 52-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Specifically, these claims comprise recitation of "active content items", such as within the phrase "highlighted as active content items" [claim 40]. The examiner notes that a standard meaning for "active" when used to describe content items does not exist amongst those of ordinary skill in the art. It is noted that an applicant can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. In the instant case, however, the applicant fails to provide a definition for "active" as would be applied to "active" content items as well as the applicant fails to clearly set forth within the applicant's specification the meaning of "highlighted as active content items" as would be applied to content items. Thus, the scope of claims 40, 41, and 52-63 is rendered unclear. For the purpose of examination, the examiner presumes the reference to the terms "active" or "highlighted as active", nominally describing a content item, to mean the intention of some sort of activity, operation, capability, or expression to be associated with the content item.

Furthermore, regarding claim 40, the recitation, "the list of content items highlighted as active content items" lacks antecedent basis within the claim terminology. For the purpose of examination, the examiner presumes the applicant to recite "a list of content items highlighted as active content items".

**Claim Rejections - 35 USC § 102**

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 40, 41, 52-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmelzer, "Copyright Detection and Protection System and Method", U.S. Patent Publication 2003/0037010.**

Regarding claim 30, Schmelzer discloses:

*maintaining a list of content items, the list of content items being associated with one or more fingerprints derived from the data representing audio or video samples corresponding to the content items (par. 6, 7, 34 – herein it is shown that the list comprises registered and monitored (i.e. "active") copyrighted works, a subset of all copyrighted works);*

*identifying a subset of the list of content items highlighted as active content items, the subset comprising content items subject to updates; using a programmed electronic processor, deriving at least one fingerprint from a content item monitored or obtained from a network; and interrogating the list of content items with the at least one fingerprint to identify the monitored or obtained content item (par. 34)*

1  
2  
3       Regarding claims 41, 52, and 53, Schmelzer discloses, “*wherein the content*  
4 *items comprise at least audio or video*” (par. 6, 7, 34), “*said act of deriving comprises*  
5 *deriving two or more fingerprints of the content item*”, “*said act of interrogating the list of*  
6 *content items utilizes the two or more fingerprints*” (fig. 2, 4, 6 - herein a plurality of  
7 identifiers (“fingerprints”) are derived and used for identifying listed content items).

8  
9       Regarding claims 54 and 55, Schmelzer discloses  
10       “*with each item on the list of content items being associated with one or more*  
11 *fingerprints derived from the respective content item itself*”, (fig. 2, 4, 6 - herein a  
12 plurality of identifiers (“fingerprints”) are derived and used for identifying listed content  
13 items) and “prior to said act of interrogating, updating the subset” (Schmelzer, par. 67,  
14 83 – herein Schmelzer discloses that content items are permitted to be updated prior to  
15 the method of interrogating).

16  
17       Regarding claims 56 – 63, Schmelzer discloses the use of a programmed  
18 computing device, programmed by computer instructions, for performing the disclosed  
19 method (e.g. fig. 1).

20



***Response to Arguments***

Applicant's arguments filed 2/18/2010 have been fully considered but they are not persuasive.

*Applicant argues or asserts essentially that:*

In particular, it appears that the term "active" is questioned. The Office Action suggests that a definition is not provided for the term. See the Office Action, page 7, lines 17-21. We disagree.

For example, the Specification provides a definition as follows on pages 11, lines 25-29.

*Wherever the database is located, the database can have only entries for songs included in the play list, or songs in the play list are highlighted as active. The latter means only the active entries are changed when the play list is updated, whereas the former means the database entries for newly added songs have to be added and database entries for songs in the database not included in the new play list have to be deleted. (Remarks, pg. 6)*

*Examiner respectfully responds:*

The examiner respectfully disagrees with the applicant's allegation, and notes that it appears clear that within the cited portion of the applicant's disclosure there does not appear any definition of the term "active".

*Applicant argues or asserts essentially that:*

The drawings and specification are objected to variously for needing to show each features of the claims, and for introducing new subject matter. We traverse these rejections and ask for reconsideration in view of the above comments (under "Formal Rejections"). (Remarks, pg. 7)

*Examiner respectfully responds:*

The examiner respectfully notes that applicant's remarks fail to address the features noted as missing from the drawings and as objected to within the claims. Thus, the examiner finds the applicant's remarks unpersuasive.

*Applicant argues or asserts essentially that:*

There, the Office Action suggests that no patentable weight should be given to the phrase "subject to updates." We disagree.

First, we note that this is a mere conclusory statement, which cuts against the requirements of KSR and other legal precedent. (Remarks, pg. 7)

*Examiner respectfully responds:*

The examiner respectfully notes that applicant's argument is essentially similar to those of record. The examiner maintains that the rejection explicitly shows that the list of content items is updated (e.g. see Final Rejection, 7/24/08, pg. 7, 8). Thus, the

examiner respectfully notes that applicant's allegation that the rejection fails to support the rejection of the language (i.e. the subset being associated with those content items being subject to updates) clearly appears unpersuasive.

Furthermore, the examiner respectfully notes that the applicant's nominal description of content as "subject to updates" fails to impart any functional limitation to the claimed method. Thus, the examiner finds the applicant's assertions that the prior art fails to meet the claimed limitations to be unpersuasive.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**See Notice of References Cited.**

A shortened statutory period for reply is set to expire 3 months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery Williams/  
Examiner, Art Unit 2437

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2437